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PATENT

Attorney Reference Number 6424-61326-01
Application Number 10/035,814

REMARKS:

Reconsideration of the application is respectfully requested in view of the foregoing amendments and following remarks. Claims 1-47, 55-56, 59-63, 65-67, 70, 72, 87-92 and 94 are pending in the application. No claims have been allowed. Claims 1, 33, 41, 46, 55, 56, 59, 63, 70, 72, 87, and 94 are independent. Claim 64 is canceled without disclaimer or prejudice to renewal.

Interview Summary

Applicant wishes to thank Examiner Kaveh Abrishamkar for his time during a telephonic interview on January 26, 2006. Possible amendments to claim 1 were discussed.

Cited Art

The Action cites various patent documents, including: U.S. Patent No. 6,640,211 to Holden ("Holden"); U.S. Patent No. 6,670,731 to Huff ("Huff"); U.S. Patent No. 5,659,741 to Eberhardt ("Eberhardt"); and U.S. Patent No. 6,757,720 to Weschler, Jr. ("Weschler").

Patentability of Claims 1-32 over Holden, Huff, Weschler, and Eberhardt under § 102 and § 103

The Action continues to reject claim 1 and cites to Holden. In particular, the Action states at Page 2:

Regarding amended independent claim 1, the applicant argues that the CPA, Holden, Huff, Weschler, and Eberhardt do not teach the newly added limitation of "members interested in avoiding or treating a particular medical condition." This argument is not found persuasive. Holden discloses "the patient has control to voluntarily allow access to particular people" (column 1 lines 65-67), and further discloses that a medical practitioner "can run tests based on the profile" (column 1 lines 50-53). It is believed that these cited passages teach a group (the patient, the medical practitioner and others allowed access by the patient), and that the members are interested in treated or avoiding a particular medical condition based on the test that are performed.

In an effort to expedite prosecution to find mutually-agreeable allowable subject matter, Applicant has added language to clarify that "a plurality of the participants . . . are members of a group."

To further clarify groups, Applicant has added the following language to claim 1:

wherein the group is designated for a plurality of participants having a similar gene, illness or disease.

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Support is found, for example, at Page 4, line 23 of the Application.

For the recited groups, the Action continues to rely on Weschler and Eberhardt in combination with Holden and Huff. The amended claim, however, recites an arrangement not taught or suggested by these references, alone or in combination.

Weschler's description of groups would not lead one to the recited "wherein the group is designated for a plurality of participants having a similar gene, illness or disease." At column 11, lines 60 et seq., Weschler describes:

Group plug in 322 is used to define and manage group specifications in profile service 301. A group is an organizational entity that includes members that have shared attribute information by virtue of their membership. A group may be, for example, a workgroup or team within an organization, a suite of software applications, a group of hard disk drives that form a RAID storage set, and the like. The members of each group may share specified privileges or have specified restricts imposed on them.

Thus, Weschler does describe "[a] group is an organizational entity that includes members that have shared attribute information by virtue of their membership." However, a mention of "a workgroup," "team," or "group of hard disk drives" would not lead one of skill in the art to all possible groups, and certainly not to "a plurality of participants having a similar gene, illness or disease" as recited in claim 1. As understood by Applicant, Weschler is concerned with organizational entities, not medical conditions. Thus, even if Weschler were combined with Holden and Huff, it would not lead to the recited arrangement.

Eberhardt's description of a group of patients would not lead one to the recited "provide group members with access to genomic profile information group functions and information." At column 8, lines 34 et seq., Eberhardt describes:

It is considered that this function of the CS of this invention will provide means whereby, for the first time in history, the reactions (good, bad or none) of a very large group of patients taking a given medicine can be monitored continuously by computer and then the results can be rapidly reported to the pharmaceutical or other manufacturer of the medication. This is in contrast to the present system wherein drug companies do not have any systematic means for collecting on-going information from persons using their drugs.

Thus, Eberhardt does describe "group of patients taking a given medicine can be monitored continuously by computer." However, one of skill in the art would not be led to "provide group

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members with access to genomic profile information group functions and information" from a mere mention of a group of patients. The passage in Eberhardt does not teach or suggest that *members in the group* could access their information via a system such as that recited in claim 1.

Eberhardt's description of a user activating a New Record Window key does not teach or suggest the recited "provide group members with access to genomic profile information group functions and information." Eberhardt goes on to discuss further details at column 11, lines 35 et seq.:

If the user activates the New Record Window Key, moves the cursor to a field within the record, and clicks the mouse button, text can be entered into that field, primarily about the patient.

However, "the user" still does not teach or suggest "provide group members with access." Eberhardt does not describe that members in the group are provided with access to the described software system.

For at least these reasons, claim 1 and its dependent claims, 2-32, are allowable over Holden, Huff, Weschler, and Eberhardt.

Patentability of Claims 33-40

Applicant has added the following language to claim 33:

wherein members of the group are limited to those having a particular medical condition . . .

Support is found, for example, at Page 38, lines 13-15 (claim 66). As understood by Applicants, such an arrangement is novel and non-obvious over Holden, Huff, Weschler, and Eberhardt. Therefore, claim 33 and its dependent claims, 34-40, are allowable at this time.

The Remaining Claims

In the interest of brevity, Applicant simply points out that the other independent claims have had language added to them regarding "groups." Each of the claims is thus patentable over Holden, Huff, Weschler, and Eberhardt.

Request for Interview

If any issues remain, the Examiner is formally requested to contact the undersigned attorney prior to issuance of the next Office Action in order to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution. Applicants submit

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the foregoing formal Amendment so that the Examiner may fully evaluate Applicants' position, thereby enabling the interview to be more focused.

This request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.


Conclusion

The claims in their present form should now be allowable. Such action is respectfully requested.

Respectfully submitted,

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